

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 31, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re The Trustee of the Markeeta E. Maki Revocable Living Trust
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Application Serial No. 90738341
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Andrew T. Schmid and Brandon C. Griffith of Miller Johnson,
for the Trustee of the Markeeta E. Maki Revocable Living Trust.

Kerry A. Nicholson, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

—
Before Bergsman, Lykos, and Dunn,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

The Trustee of the Markeeta E. Maki Revocable Living Trust (“Applicant”) seeks registration on the Principal Register of the mark ICE CREAM BANDITS and design, reproduced below, for “milk shakes; milk beverages, milk predominating,” in International Class 29, and “chocolate, ice cream,” in International Class 30.¹

¹ Application Serial No. 90738341 was filed on May 27, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as May 8, 2020, for the goods in both International Classes.



In its application, Applicant describes the mark as follows:

The mark consists of a stylized raccoon with the stylized wording “ICE CREAM BANDITS” appearing to the left of the raccoon. The raccoon appears in gray with tan and white accents on its belly, ears, and eyebrow, a striped black and gray tail, a black nose and black eyes with white accents, black eyelashes, and a black mouth. The raccoon’s eyes are outlined with a partial peach and white border. Each element of the raccoon appears outlined in black. The raccoon appears wearing a purple eye mask and holding a peach ice cream cone with white ice cream, all of which is outlined in black. The stylized wording “ICE CREAM” fades top to bottom from peach to purple, and the stylized wording “BANDITS” fades top to bottom from purple to peach. The letter “n” in “BANDITS” forms a stylized drip that appears in peach. The wording in the mark appears outlined in black. The remaining white in the mark represents background and is not part of the mark.

The color(s) gray, white, black, tan, purple, peach is/are claimed as a feature of the mark.

Applicant disclaims the exclusive right to use the term “Ice Cream.”

The Examining Attorney refused to register Applicant’s mark for both classes of goods under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the registered mark SWEET BANDIT (in standard characters)

for “candy; sweets,” in International Class 30, as to be likely to cause confusion. Registrant disclaimed the exclusive right to use the word “Sweet.”²

When we cite to the record, we refer to the USPTO Trademark Status and Document Retrieval (TSDR) system in the downloadable .pdf format by page number (e.g., October 25, 2021 Office Action (TSDR 24)). When we cite to the briefs, we refer to TTABVUE, the Board’s docketing system, by docket number and page number (e.g., 6 TTABVUE 4).

I. Preliminary issues

A. Applicant’s embedded list of third-party registrations, reference to a cancelled registration for CINNAMO BANDIT, and TESS search

In its July 27, 2022 Response to an Office Action, Applicant embedded a table of 11 third-party registrations consisting in part of the word “Bandit” for goods in International Classes 29 and 30.³ The table includes the mark, registration number, International Class and goods. Applicant did not submit a copy of the registrations.

In addition, Applicant referred the following search its counsel conducted in the USPTO Trademark Electronic Search System (TESS):

[A] trademark search of the federal registry returns thousands of marks in class 30 with goods/services that list both candies ***and*** chips or tortillas. A similar search for marks in class 30 that list candies ***and*** salsa or “hot sauce” results in over two thousand records.⁴

² Registration No. 5752325 registered May 14, 2019.

³ July 27, 2022 Response to Office Action (TSDR 18-19).

⁴ *Id.* at TSDR 17-18. Applicant executed the searches on July 26, 2023. *Id.*

According to Applicant, “the strength of the Cited Mark of SWEET BANDIT depends at least on the goods in the foodstuffs classes that include snack foods, salsas, and hot sauces.”⁵ Applicant did not include a copy of the TESS search report.

Finally, Applicant referred to a canceled registration for CINNAMO BANDIT for candies. According to Applicant Registrant’s SWEET BANDIT mark was published, registered, and co-existed with CINNAMO BANDIT as recently as February 14, 2020.⁶ Applicant did not include a copy of the registration for CINNAMO BANDIT, nor did Applicant provide a registration number.

In the next Office Action, the Examining Attorney acknowledged Applicant’s submission of the embedded table of third-party registrations and addressed their evidentiary value.⁷ The Examining Attorney also addressed Applicant’s argument regarding the cancelled registration for the mark CINNAMO BANDIT.⁸ The Examining did not object to the Applicant’s embedded table of third-party registrations or Applicant’s reference to the cancelled CINNAMO BANDIT registration, nor did he explain how Applicant should introduce third-party registrations into the record. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) §710.03 (July 2022) (“If the applicant’s response includes improper evidence of third-party registrations, the examining attorney must object to the evidence in the first Office action following the response.”).

⁵ *Id.* at TSDR 18.

⁶ *Id.* at TSDR 19.

⁷ October 23, 2022 Office Action (TSDR 7-8).

⁸ *Id.* at TSDR 8.

The Examining Attorney did not acknowledge or address Applicant's reference to Applicant's TESS search for candies and chips, tortillas, salsa, or hot sauce.

Mere listings of registrations are not sufficient to make the registrations of record. *See e.g., In re Brunetti*, 2022 USPQ2d 764, at *4-6 (TTAB 2022) (applicant's references in his briefs to third-party registrations and applications that were not of record were improper and given no consideration), *appeal docketed*, No. 23-1539 (Fed. Cir. Feb. 27, 2023); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012) (mere listing of third-party registrations in brief insufficient to make them of record); *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998).

In limited circumstances the Board will consider such listings. In particular, if, as in this appeal, an applicant includes a listing of registrations in a response to an Office action, and the examining attorney does not advise the applicant that the listing is insufficient to make the registrations of record at a point when the applicant can correct the error, the examining attorney will be deemed to have waived any objection to consideration of the list itself, for whatever probative value it may have. *See In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1594 n.40 (TTAB 2014) (objection waived where examining attorney, in continuing a refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record); *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012) (“[T]he examining attorney’s failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any

objection to consideration of that list. Accordingly, we will consider the ... list of registrations ... ‘for whatever limited probative value such evidence may have.’”) (citing *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001)), *aff’d*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1717 (TTAB 2011) (specific data provided by applicant considered because examining attorney did not advise applicant that a listing of registrations was insufficient when applicant had time to cure the defect).

Similarly, if the examining attorney discusses the registrations in an Office action or brief, without objecting to them, as he failed to do here, the registrations will be treated as stipulated into the record. *See In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) (although the Board does not take judicial notice of registrations, because the examining attorney addressed applicant’s two registrations in her brief and neither objected to the other’s discussion of the registrations, Board treated both registrations as though they are of record); *In re Total Quality Grp. Inc.*, 51 USPQ2d 1474, 1477 n.6 (TTAB 1999) (examining attorney did not object to listing of third-party registrations, rather he treated the registrations as if they were of record); *Dos Padres*, 49 USPQ2d at 1861 n.2 (examining attorney did not object to and treated as of record listings from a commercial trademark search report submitted by applicant during prosecution, so Board considered material).

Accordingly, we consider the embedded list of registrations, the cancelled registration for the mark CINNAMO BANDIT, and Applicant’s TESS search for

candies and chips, tortillas, salsa, or hot sauce for whatever probative value they may have. *See* the discussion below.

B. Examining Attorney’s objection to late-filed evidence

The Examining Attorney, in his brief, noted that “applicant seeks to enter new evidence to overcome the refusal” and objected to the evidence as untimely.⁹ According to the Examining Attorney, the Board should “disregard the third-party registrations references by applicant in its appeal brief.”¹⁰

The only third-party registration evidence discussed in Applicant’s brief is the third-party registration evidence we discussed in the preceding section. As discussed above, in its July 27, 2022 Response to an Office Action, Applicant referred to an embedded list of registrations, the cancelled registration for the mark CINNAMO BANDIT, and Applicant’s TESS search for candies and chips, tortillas, salsa, or hot sauce, to which the Examining Attorney did not lodge an objection and substantively discussed.

Because this evidence is not new, therefore, we overrule the objection.

II. Likelihood of confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used

⁹ Examining Attorney’s Brief (6 TTABVUE 2).

¹⁰ *Id.* at TSDR 3.

on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

We base our determination under Section 2(d) on an analysis of all the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at *4 (Fed. Cir. 2023) (“In any given case, different *DuPont* factors may play a dominant role and some factors may not be relevant to the analysis.”); *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.”

Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc., 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.’” *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). *See also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

A. The similarity or dissimilarity and nature of the goods

Applicant is seeking to register its mark for “milk shakes; milk beverages, milk predominating” in International Class 29 and “chocolate, ice cream” in International Class 30. The mark in the cited registration is registered for “candy; sweets.”

The MERRIAM-WEBSTER DICTIONARY ([merriam-webster.com](https://www.merriam-webster.com)) defines “sweets” as being, inducing, or marked by one of the five basic taste sensations that is usually

pleasing to the taste and typically induced by sugars (as sucrose or glucose)” and as “something that is sweet to the taste: such as a food (such as candy or preserve) having a high sugar content.”¹¹ It defines “ice cream” as “a sweet flavored frozen food containing cream or butterfat and usually eggs.”¹² Based on the dictionary definitions, Registrant’s “sweets” (something that is sweet) encompasses Applicant’s “ice cream” (a sweet flavored food). *See Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013) (applying the principle that “registration encompasses all goods or services of the type described); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1413-14 (TTAB 2018) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

Likewise, a “milk shake” falls within the broad definition of a “sweet.” The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed August 26, 2023) defines a “milk shake” as “a thoroughly shake or blended drink made of milk, flavoring syrup, and often ice cream.”¹³ It defines “syrup,” *inter alia*, as “a thick sticky solution of sugar and water often flavored or medicated.”

¹¹ February 14, 2022 Office Action (TSDR 10 and 12).

¹² *Id.* at TSDR 24.

¹³ *See also* THE RANDOM HOUSE UNABRIDGED DICTIONARY (2023) (accessed August 26, 2023) posted on Dictionary.com defining a “milk shake” as “a frothy drink made of cold milk, flavoring, and usually ice cream, shaken or blended in a mixer.”).

We find that Applicant’s “milk shakes” in International Class 29 and “ice cream” in International Class 30 are in part legally identical to Registrant’s broadly delineated “sweets”. Under this *DuPont* factor, the Examining Attorney need not prove, and we need not find, similarity as to each product listed in the description of goods. It is sufficient for a refusal based on likelihood of confusion that we find any item encompassed by the identification of goods in a particular class in the application and registration related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at *3-4 (TTAB 2020); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).

Applicant, in its brief, does not contest that the goods are related.

B. Established, likely-to-continue channels of trade and classes of consumers

Because the goods described in each class in the application and the cited registration are in part legally identical, we presume that the channels of trade and classes of purchasers are the same for both Classes 29 and 30. *See Viterra*, 101 USPQ2d at 1908 (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (“With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed

The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *2 n.17 (TTAB 2019).

our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods....’); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014).

C. The strength of Registrant’s SWEET BANDIT trademark

The strength of Registrant’s mark affects the scope of protection to which it is entitled. Thus, we consider the inherent or conceptual strength of Registrant’s mark based on the nature of the mark itself and its commercial strength based on marketplace recognition of the mark. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at *4 (Fed. Cir. 2023) (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”)); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2023 update) (“The first enquiry is for conceptual strength and focuses on the

inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.”).¹⁴

At a minimum, Registrant's mark SWEET BANDIT has been registered on the Principal Register without a claim of acquired distinctiveness and, therefore, it is inherently distinctive and entitled to the benefits accorded registered marks under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b) (registration is prima facie evidence of the validity of the registration and registrant's exclusive right to use the mark in commerce). *See, e.g., Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017) (Board gave cited mark “the normal scope of protection to which inherently distinctive marks are entitled.”).

The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed August 25, 2023) defines “Bandit” as “an outlaw who lives by plunder,” or a “robber.”¹⁵ As such, “Bandit” does not have a descriptive or suggestive meaning when used in connection with Registrant's “candy; sweets.” Therefore, “Bandit” is an arbitrary and inherently strong mark. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as a “known word

¹⁴ The owner of the cited registration is not a party to this proceeding and thus cannot introduce evidence regarding its use of the mark protected thereby. *See In re Thomas*, 79 USPQ2d 1021, 1027, n. 11 (TTAB 2006) (“Because this is an *ex parte* proceeding, we would not expect the examining attorney to submit evidence of fame of the cited mark”).

¹⁵ The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *2 n.17 (TTAB 2019).

used in an unexpected or uncommon way” and observing that such marks are typically strong); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (arbitrary terms are conceptually strong trademarks); *Mishawaka Rubber & Woolen Mfg. Co. v. Bata Narodni Podnik*, 222 F.2d 279, 105 USPQ 432, 437 (CCPA 1955) (“A strong and fanciful mark is entitled to broad protection.”); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1479 (TTAB 2007) (completely unique and arbitrary, if not coined, nature of mark in relation to goods entitles the registered mark to a broad scope of protection, and significantly increases the likelihood that the marks, when used in connection with the identical goods would cause confusion).

However, since Registrant’s mark is SWEET BANDIT, we must consider how the meaning of the word “Sweet” in the mark SWEET BANDIT affects conceptual strength. As discussed above, the MERRIAM-WEBSTER DICTIONARY defines “Sweet” as “being, inducing, or marked by one of the five basic taste sensations that is usually pleasing to the taste and typically induced by sugars (as sucrose or glucose)” and “something that is sweet to the tastes: such as a food (such as a candy or preserve) having a high sugar content.”¹⁶ As noted in footnote 2 above, Registrant disclaimed the exclusive right to use the word “Sweet.” Therefore, we find that SWEET BANDIT means and engenders the commercial impression a robber who steals sweets. Accordingly, Registrant’s mark SWEET BANDIT falls between arbitrary and suggestive but remains a conceptually strong mark.

¹⁶ February 14, 2022 Office Action (TSDR 10 and 12).

As discussed above, Applicant embedded 11 third-party registrations for marks incorporating “Bandit” for goods in International Classes 29 and 30.¹⁷ We reproduce Applicant’s table below:

Mark	Reg. No.	Class	Goods
Bandito’s All Natural (design)	6153888	30	Corn based snack foods, namely, chips.
Bandit’s Bounty (design)	5511888	30	Corn-based snack foods
Bandit’s Bounty	5511816	30	Corn-based snack foods
Locos Banditos	5368710	30	Food, namely, tea, tea extracts, tea-based beverages, coffee-based beverages, snack foods in the nature of wheat based snack food, corn based snack food; prepared and packaged meals and food package combinations consisting primarily of pasta or rice.
Bandana Bandito (design)	5358349	30	Salsa

Buffo’s Blazin Bandito Jalapeno Pepper Hot Sauce (design)	5322615	30	Hot Sauce; Condiment, namely, pepper sauce
Bandana Bandito	5270985	30	Salsa
Gringo Bandito	4613442	30	Hot Sauce; gift baskets containing hot sauce and tortilla chips; gift baskets containing hot sauce, tortilla chips, caps, t-shirts, novelty buttons, and stickers
Green Bandit	2618923	30	Sauces including, but not limited to, hot and picante sauces
Nature’s Bandit (design)	5215200	29	Dried Fruits
Nature’s Bandit	5215200	29	Dried Fruits

¹⁷ July 27, 2022 Response to Office Action (TSDR 18-19). Registration No. 5215200 for the mark NATURE’S BANDITS and design and Registration No. 5215199 for the mark NATURE’S BANDITS (standard characters) both registered May 30, 2017. To date the Section 8 declaration of use due May 30, 2023 have not been filed. The grace period expires November 30, 2023.

Registration No. 2618923 for the mark GREEN BANDIT is cancelled for failure to file a Section 8 and 9 declaration.

Only Registration Nos. 5215199 and 5215200 for the marks NATURE'S BANDIT and NATURE'S BANDITS and design are relevant because they are registered for dried fruit that may fall within the penumbra of sweets. The other third-party registrations Applicant submitted are of limited, if any, probative value because they do not cover the goods in the cited registration (i.e., "candy; sweets"). *See Omaha Steaks*, 128 USPQ2d at 1694 (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus "on goods shown to be similar"); *i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration); *TAO Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (third party registrations in unrelated fields "have no bearing on the strength of the term in the context relevant to this case."); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue). *See also Key Chem., Inc. v. Kelite Chem. Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) ("Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word 'KEY'. The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they are in continued use. We, therefore, can give them but little weight in the circumstances present here.").

In addition, unlike cases in which extensive evidence of third-party use and other evidence in the record was found to be “powerful on its face” inasmuch as “a considerable number of third parties use [of] similar marks was shown,” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015), Applicant has presented only two relevant third-party registrations, well short of the volume of evidence found convincing in *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) and *Juice Generation*.

As noted above, Applicant refers to a cancelled registration for the mark CINNAMO BANDIT for candies¹⁸ to which Applicant contends impacts the strength of the Registrant’s mark SWEET BANDIT.¹⁹ We disagree. First, a cancelled or expired registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything.”); *In Re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007). *In re Hunter Publ’g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(b)] presumptions and makes the question of registrability ‘a new ball game’ which must be predicated on current thought.”).

¹⁸ Registration No. 4366069 registered July 9, 2013; cancelled February 14, 2020.

¹⁹ Applicant’s Brief, pp. 14-15 (4 TTABVUE 15-16).

Second, even assuming arguendo, that the cancelled registration had some probative value and we considered it along with the NATURE'S BANDIT registrations for preservatives, three registrations does not prove that the word "Bandit" has a suggestive significance when used in connection with candy or sweets.

The third-party registrations do not detract from the inherent or conceptual strength of Registrant's mark SWEET BANDIT.

D. The similarity of dissimilarity of the marks

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

In comparing the marks, we are mindful that where, as here, the goods are in part legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23

USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007);

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.*, 101 USPQ2d at 1721); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012).

The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980). Because Applicant is seeking to register its mark for “milk shakes; milk beverages, milk predominating” and “chocolate, ice cream” and Registrant’s mark is registered for “candy; sweets,” the average customer is an ordinary consumer.

We keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

As noted above, the mark in the cited registration is SWEET BANDIT, in standard characters, and Applicant is seeking to register the mark ICE CREAM BANDITS and design, reproduced below:



With respect to Applicant's mark ICE CREAM BANDITS and design, the word "Bandits" is the dominant part of the mark. "In the case of marks, such as Applicant's, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods." *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because "[t]he word portion of a word and design mark 'likely will appear alone when used in text and will be spoken when requested by consumers.'" *Aquitane Wine USA*, 126 USPQ2d at 1184 (quoting *Viterra*, 101 USPQ2d at 1911).

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their

entireties. *Viterra*, 101 USPQ2d at 190; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In addition, because the term “Ice Cream” is merely descriptive when used in connection with milk shakes and ice cream, Applicant has disclaimed the exclusive right to use “Ice Cream.” It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations because consumers will tend to focus on the more distinctive parts of marks. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *Nat'l Data Corp.*, 224 USPQ at 752); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression.”).

With respect to the registered mark SWEET BANDIT, the word “Bandit” is the dominant part of the mark. As discussed in the previous section, the word “Sweet” is merely descriptive when used in connection with “candy; sweets” (i.e., it means a food such as a candy or preserve) and Registrant disclaimed the exclusive right to use it.

The difference between Applicant’s use of “Bandits” and Registrant’s use of “Bandit” is insignificant. *See Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (finding no material difference between the singular and plural forms

of ZOMBIE such that the marks were considered the same mark); *Weidner Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (finding that SHAPE and SHAPES are virtually the same marks); *In re Pix of Am., Inc.*, 225 U.S.P.Q. 691, 692 (TTAB 1985) (noting that the pluralization of “Newport” is “almost totally insignificant in terms of the likelihood of confusion of purchasers.”).

ICE CREAM BANDITS and SWEET BANDIT mean essentially the same thing and engender similar commercial impressions. ICE CREAM BANDITS are robbers who steal ice cream, a sweet, while SWEET BANDIT is a robber who steels sweets.

Although we have pointed to the identical dominant portions of the marks, we acknowledge the fundamental rule that we must consider the marks in their entireties. See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272, 273-74 (CCPA 1974). We note the specific differences pointed out by Applicant; specifically Applicant’s “eye-catching cartoon.”²⁰ However, the “colorful cartoon racoon holding an ice cream cone”²¹ also projects the commercial impression of sweet bandit inasmuch as racoons are noted for their masks not unlike a bandit might wear.

For these reasons, the differences between the marks are outweighed by their similarities. Thus, when comparing the marks overall, they are similar in sound,

²⁰ Applicant’s Brief, p. 7 (4 TTABVUE 8).

²¹ *Id.*

connotation and commercial impression. This *DuPont* factor weighs in favor of finding a likelihood of confusion.

D. Conclusion

The record does not show that the cited mark is conceptually weak. Therefore, because the marks are similar, the goods are in part legally identical as to both classes and we presume that they are offered in the same channels of trade to the same classes of consumers, we find that Applicant's mark ICE CREAM BANDITS and design for "milk shakes; milk beverages, milk predominating" and "chocolate, ice cream" is likely to cause confusion with the registered mark SWEET BANDIT for "candy; sweets."

Decision: We affirm the refusal to register Applicant's mark ICE CREAM BANDITS and design for the goods identified in both International Classes 29 and